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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,514	11/02/2000	Jeffry Jovan Philyaw	PHLY-25,509	6936
25883 7590 07/18/2007 HOWISON & ARNOTT, L.L.P. P.O. BOX 741715 DALLAS, TX 75374-1715			EXAMINER POLLACK, MELVIN H	
			ART UNIT 2145	PAPER NUMBER
			MAIL DATE 07/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/705,514

Applicant(s)

PHILYAW, JEFFRY JOVAN

Examiner

Melvin H. Pollack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 15-20 and 38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15-20 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> . |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 16 May 2007 have been fully considered but they are not persuasive. An analysis of the arguments is provided below.
2. Regarding the abstract, the applicant wishes for clarification of his objection to the abstract (P. 7). Terms identified as "legal phraseology" are not, as the applicant somehow determined, to be defined as any and all terms that could ever appear in any legal document. Rather, they are terms that are not commonly used, such as jargon and other forms of legalese. These terms may be used in the claims and other parts of the disclosure, i.e. means and said, but are to be avoided in an abstract. See MPEP 608.01(b).
3. The examiner specifically objected to the phrase "The present invention disclosed and claimed herein comprises..." This phrase includes many items of legalese (claimed herein, comprises), as well as non-concise statements that can be implied (present invention disclosed and claimed). Since the phrase was deleted, the objection is withdrawn.
4. The applicant defines the claims (Pp. 7-8) wherein a control signal may be any content-related information other than the visual cue, and may even be instructions to the display regarding the location and characteristics of a visual cue, or an audio or visual signal that complements the visual cue. (That said, claim 1 adds that the control signal contains location information accessible by an input device, lines 12-17). Releasing the control signal is simply transmitting the broadcast, while occurrence is simply displaying the broadcast. In light of the remarks and amendments, the 112 rejection is withdrawn.

5. Applicant argues that Wagner does not expressly disclose that “the visual cue is provided subsequent to the ‘occurrence of a control signal that is part of the broadcast presentation.’”

Applicant’s argument seems to be limited to the fact that Wagner may or may not do so (Pp. 8-9). That Wagner teaches one embodiment that matches the limitation is enough to teach on the limitation; there is no requirement that it be the sole embodiment. The examiner uses the VBI inclusion embodiment.

6. In response to applicant's argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., “control signal is a signal that is received and reproduced as a portion of the normal broadcast... with the visual cue”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). This is not the same as releasing in conjunction with the presentation, or providing subsequent.

7. Applicant argues that Wagner does not expressly disclose the step of releasing the control signal (Pp. 9-10). While it is true that the examiner did not fully understand the boundary between releasing the control signal and interacting with the signal, the usage of establishing a connection still shows the release and occurrence of a control signal. The development of an interactive display requires a visual cue (icon) and instructions relating to the visual cue (what happens when a user reacts to the icon). Since the icon appears without manual intervention, the release and occurrence are fully automatic.

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8. The user operations that the applicant mentions all occur after the release and occurrence of the control signal, as currently defined. Not only does the applicant not preclude later interventions with the visual cue, but also the independent claims describe a control signal recognized and modified by an input device (see also Figs. 16-26 and 30), such that the computer may interact with a visual cue to bring up information on the network.

9. Applicant argues that the animated character, although only a portion moves, does not operate by detaching one or more moving segments (character's arms) from a stationary portion (character's body) and then traversing a path (P. 10).

10. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the particular implied definition of detaching and traversing) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11. The examiner interprets the limitation broadly, in light of the lack of description as to this operation. As such, a character that partly moves, thanks to the operations of superposition and transparency, fulfill this obligation. This character is also differentiated from the progress indicator (Fig. 7, #50), which is a mere series of discrete images (Fig. 8)

12. Applicant argues that Wagner does not teach the step of releasing a control signal through the provision of a light signal (P. 10). While it is true that the control signal of claim 1 is provisioned from the content provider, the input device provides the light signal (comprising the control signal) of claim 15. The examiner interprets this control signal as either a separate type

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of control signal or as a request to release a subsequent control signal. In either case, a command from an input device that causes a subsequent broadcast of information clearly fulfills the limitation, provided the request be a recognizable light wave.

13. In the specification, the example embodiment is a wand or barcode reader (Fig. 16), but the claims do not limit as such. A remote control that communicates with a set-top box via infrared link (IR is by definition a light wave of non-visible spectrum) easily fulfills the limitation.

14. Applicant argues that a description of the visual cue is functional because applicant wrote the description as a method claim. It is not the usage of a magic keyword that makes a limitation patentable and functional subject matter, but rather the particulars of the claim limitation and what it adds to the parent claims. See MPEP 2106.

15. For the reasons above, the rejection is maintained. This rejection is final.

Claim Rejections - 35 USC § 112

16. Claims 1-11, 15-20 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17. Claims 1-11, 15-20 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the relationship between the input device and

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provided signal, and the control signal and its release and control. In particular, claims 11 and 15 seem at odds with claim 1 in light of the description in the remarks, and the applicant must clarify claim 1 in order to iron out the inconsistencies.

18. Claim 1 also recites the limitation "presentation broadcast" in line 12. There is insufficient antecedent basis for this limitation in the claim. The examiner assumes that the applicant meant "broadcast presentation."

Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20. Claims 1-3, 6-8, 10, 11, and 15-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Wagner et al. (6,600,496).

21. For claim 1, Wagner teaches a method (abstract) for facilitating computer based access to a location on a network (col. 1, line 1 – col. 3, line 25; col. 8, lines 35-45) by a consumer witnessing a presentation broadcast to the consumer over a broadcast network that is operable to make available to a plurality of consumers the presentation broadcast (Fig. 2), comprising the steps of:

- a. Providing a visual cue during the presentation broadcast apparent to the consumer and indicative of a relationship between the visual cue and the presence of the location on the network that will attract the consumer's attention (col. 6, lines 30-55), the visual cue

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provided subsequent to the occurrence of a control signal that is part of the presentation broadcast and which control signal is in association with the visual cue (col. 6, lines 20-30); and

b. Releasing the control signal (col. 7, lines 10-16; establishing the connection), the step of releasing occurring during the presentation broadcast (col. 5, lines 40-50), and wherein a computer (Fig. 1, #2) having an input device responsive to the control signal (Fig. 1, #4) can be controlled such that the control signal can both be recognized by the input device (Fig. 2) and control information contained in the control signal can be extracted therefrom to enable and control the computer to access the location on the network upon the appearance of the visual cue and receipt of the control signal during the presentation broadcast (col. 6, lines 20-55), which control is facilitated from the presentation broadcast with no user intervention (col. 7, lines 10-35).

22. For claim 2, Wagner teaches attracting the consumer's attention to the computer for interacting with the location on the network in association with the access thereto (col. 6, lines 30-45).

23. For claim 3, Wagner teaches that the step of providing a visual cue precedes the step of releasing the control signal (col. 7, lines 30-35).

24. For claim 4, Wagner teaches that the step of releasing the control signal precedes the step of providing a visual cue (col. 7, lines 30-35).

25. For claim 5, Wagner teaches that the steps of providing the visual cue and releasing the control signal occur simultaneously (col. 7, lines 30-35).

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26. For claim 6, Wagner teaches that the steps of providing the visual cue and releasing the control signal occur within a defined interval of time (col. 7, lines 30-35).

27. For claim 7, Wagner teaches animating the visual cue during its appearance wherein the animation is accompanied by the control signal (col. 6, lines 30-45).

28. For claim 8, Wagner teaches detaching one or more moving segments from a stationary portion of the visual cue, and traversing a path with each detached segment about the stationary portion of the visual cue to a predetermined position adjacent thereto (col. 6, lines 30-45).

29. For claim 10, Wagner teaches that the stationary portion of the visual cue forms an iconic figure and the moving segment resembles an element of said iconic figure (col. 6, lines 30-45).

30. For claim 11, Wagner teaches that the step of releasing a control signal comprises the step of providing an audible sound signal as a part of the broadcast having a recognizable characteristic that is identifiable each time it occurs by the input device on the computer, the sound signal comprising the control signal (col. 3, lines 20-50; radio frequency link).

31. For claim 15, Wagner teaches that the step of releasing a control signal comprises the step of providing a light signal having a recognizable characteristic that is identifiable each time it occurs by the input device on the computer, the light signal comprising the control signal (col. 3, lines 20-50; infrared link).

32. For claim 16, Wagner teaches that the visual cue includes a logo (col. 6, lines 30-45).

33. For claim 17, Wagner teaches that the presentation broadcast witnessed by the consumer includes a program having audio and video content (col. 3, lines 50-65).

34. For claim 18, Wagner teaches that the presentation broadcast witnessed by the consumer includes a broadcast communication having audio and video content (col. 3, lines 50-65).

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35. For claim 19, Wagner teaches that the presentation broadcast witnessed by the consumer includes a live presentation (Fig. 4, #9; "Live from Lincoln Center").

36. For claim 20, Wagner teaches that the presentation broadcast witnessed by the consumer includes a recorded presentation (Fig. 4, #4; "Wings").

37. For claim 38, Wagner teaches that the step of releasing the control signal occurs via the broadcast presentation ((col. 7, lines 10-16).

Claim Rejections - 35 USC § 103

38. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

39. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner as applied to claims 1, 7, 8 above.

40. For claim 9, Wagner does not expressly disclose that the stationary portion of the visual cue forms an alphanumeric character and the moving segment resembles a punctuation mark. Instead, it shows an example embodiment wherein the stationary portion is the body of an icon, while the moving segment is the icon's appendages.

41. However these differences are only found in the non-functional data stored on the article of manufacture. Data identifying a particular look of the animation is not functionally related to the substrate of the article of manufacture. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see Cf. In re Gulack*, 703 F.2d 1381,

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1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

42. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use any drawing in the animation as shown in Wagner because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious matter of design choice. See *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

Conclusion

43. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

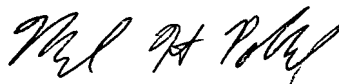
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H. Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melvin H Pollack
Examiner
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MHP
11 July 2007